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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,599

08/25/2003

Bhavesh Mehta

50269-0558

4272

73066

7590

07/27/2010

HICKMAN PALERMO TRUONG & BECKER LLP/Yahoo! Inc.

2055 Gateway Place

Suite 550

San Jose, CA 95110-1083

EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

07/27/2010

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/648,599  
Filing Date: August 25, 2003  
Appellant(s): MEHTA ET AL.

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Daniel Ledesma  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/13/2010 and 5/20/2010 appealing from the Office action mailed 12/23/2009

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Prior Board Decision in instant application (10/648,599), rendered 12/19/2007.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 21-28 and 30-37.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

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maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

US 2002/0128904

CARRUTHERS et al

9-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-28, 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carruthers et al (US2002/0128904).

Regarding claims 21, 23, 25, Carruthers et al teaches systems and methods for selecting an ad to include with a request for web content having an ad slot (i.e. ad opportunity), responsive to the content request [¶ 7, 8, 26, 76]. Carruthers et al provides a prioritized master list of ads which provides an order for the ads to be displayed [¶ 34]. Each ad has a predefined delivery criteria that is compared to the ad opportunity in order to determine a qualifying subset of ads from the prioritized master list. The ad chosen from the qualifying subset of the master queue is taken to be

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chosen based upon the sequence of the prioritized queue. Carruthers et al prioritizes the queue of ads based upon priority, a weighting indicating the number of impressions needed and based upon feedback from the system regarding which ads have been shown [¶ 34, 35]. Further, Carruthers et al states that new, proposed campaigns are analyzed and added to the system if they can be accommodated based on the expected ad inventory [¶ 8]. Carruthers et al therefore recognizes that the slot inventory is limited and that all requesting advertisers cannot necessarily be satisfied. Carruthers et al put to use a well known concept of “first-come first served” in that the first advertisers to make ad campaign contracts with the system of Carruthers et al are more likely to be accepted and to get their ads shown by the system than latecomers. It would have been obvious to one of ordinary skill at the time of the invention to have given further improved treatment to early advertisers by employing such a well known “first come, first served” notion and included prioritization of the master list of scheduled ads based upon when the advertisers contracted with the system, by comparing stored contract dates among advertisers. In this manner, ad campaigns of late coming advertisers may be accepted into the system, but would be given lower priority (i.e. placed toward the end of the queue) than earlier-arriving advertisers and such latecomers could not steal ad opportunities from earlier-arriving advertisers, even if the latecomers had ad contracts which were more “behind schedule”. The “stealing” by latecomers referred to above addresses the situation where the latecomers have a contract that if fulfilled would prevent fulfillment of an earlycomer’s contract. Late-arriving advertisers would only be served if ad inventory (available slots) was plentiful enough to fully serve the

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advertisers who came before them. This is consistent with Carruthers et al's disclosure that early adopters will be accommodated, yet late adopters will not. Further, it is pointed out that applicant's system merely lets those at the front of the line dictate how much is left for others behind them in line – much like the well known “first come, first served” approach. Regarding applicant's claimed “slot” and “slot attributes” corresponding to the subject of the requested content, it is first noted that Carruthers et al takes web surfing users who are requesting various web pages on the Internet [¶ 0016] and seeks to “optimize the use of surplus [screen] real estate” by augmenting the requested web page content with advertising such as by including a relevant banner ad [¶ 0015]. These requested web pages represent advertising opportunities having surplus screen real estate (slots where banners are to be inserted – i.e. at the top or bottom, etc., of the page or where else the page designer desires to include advertising) and the system will seek to fill this surplus real estate (slots) with inserted banner advertising. This opportunity to fill surplus real estate (slots) with ads is recognized and the system will choose an appropriate ad by matching the ad targeting criteria with the user profile [¶ 38]. This user profile used for targeting includes the user's history of websites visited, so it is dependant on specific webpages. It is important to note here that US patent application 09/558,755 (“Method and System for Web User Profiling And Selective Content Delivery”) is incorporated by reference into Carruthers et al [¶ 0014]. This 09/558,755 application describes in more detail the makeup of the user profile used by Carruthers et al to select ads to fill the ad slots. 09/558,755 describes that the user profile includes the user's “content affinity” (sports, movies, music, etc.,) which is

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derived using URLs the user has visited in the past *as well as the URL currently being requested*/browsed [pg 8: lines 15-17] and by (Neilson's) profiling of various website content indexed by URL [09/558,755 – page 7 line 21 to page 15]. From page 15:

For each visit to a Web site having a stored profile, the Web site profile is  
15 averaged or combined into the user's profile as previously discussed. The profiles  
include a rating in each category that reflects the interest in the category of persons  
who access the Web site.

Stated simply, because the user profile of Carruthers et al includes the subject/category for the page content currently being requested/browsed, the targeted banner advertisement insertion into the surplus web page space therefore meets applicant's claimed slot attributes corresponding to the content subject. Alternatively given such a teaching, it would have been obvious to one of ordinary skill at the time of the invention to have inspected the user profile or inspected the current page at any time or re-ordered the ad queue at any time, including for each advertising opportunity so that an ad can be operably targeted to the current page content as desired by the incorporated material. One of ordinary skill would have recognized the predictable advantage of targeting to current page content as the user is presumably already in the state of mind consistent with that current page content. For example, while the user is reading an article about the local sports team makes a great time to target advertising for that teams ticket plan. It would have been obvious to one of ordinary skill at the time of the invention to have provided the greater ability to finely target ad content to current page content. Further by checking the users profile, the advertising can be targeted to the most up-to-date profile and can take into consideration the user's current online

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session. Further still, Carruthers et al teaches that some advertising can be inserted according to a keyword being presented entered or to the present URL [0076].

Regarding claims 22, 28, Carruthers et al teaches that ads have delivery constraints such as maximum impressions or time between impressions [0039]. If this is the case, the ad is removed from the qualifying subset so that it is not showed for the current opportunity. This is taken to provide a step of including only ads that are not on track to be satisfied and removing all ads whose constraint is “on-track” or has been met. Alternatively, Carruthers et al teaches that each ad has delivery obligations and that determinations are made regarding whether the ad is “on track” or not. Carruthers et al demotes ads if they are on-track or have already met their delivery goals by moving them towards the bottom of the queue [¶ 35]. Carruthers et al states that ads ahead of schedule (i.e. on-track) are “effectively shut-off” by being placed at the end of the queue. Although this is taken to be effectively removed from the list, it would have been obvious to one of ordinary skill at the time of the invention to have removed such ads from the list entirely in order to ensure only ads that are behind schedule are selected. Further, one of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don’t belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result (the intended subset).

Regarding claims 24, Carruthers et al teaches that the ads are targeted to the users by matching metadata about the ads to the user's metadata (profile) [¶ 38 lines 4-5].



Regarding claims 26, Carruthers et al does not appear to specify or restrict the type of content requested to a particular format in order to include the specified advertising. Carruthers et al teaches that the ads can be banner ads or pop-up ads [¶ 15]. Carruthers et al further states that users can access files of various types via the Internet (text, images, video, etc) [¶ 20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such advertising associated with any type of electronic content such as a video stream, or even a web page that includes an embedded video stream as is well known, so that advertisers can reach a wide audience and content providers can earn advertising revenue for a variety of pages.

Regarding claims 27, Carruthers et al teaches default or filler ads that are used when no other ads are applicable for that user/slot/opportunity. This is taken to be a teaching that when there are indeed targeted ads that qualify (i.e. ads in a first priority class), that the default ads (i.e. ads in the second priority class) are not to be considered for insertion. It would have been obvious to one of ordinary skill at the time of the invention to have excluded such default ads when the “normal” ads are available. One of ordinary skill would have found it obvious to have created a subset of ads by either starting with an entire collection and eliminating ads that don’t belong, or by merely building the subset by selectively including only ads that do belong. Either approach leads to the same, predictable result.

Claims 30-37 are rejected with the same reasoning as claims 21-28.

**(10) Response to Argument**

Applicant continues to argue that Carruthers et al fails to teach or suggest selecting an earlier contracted ad rather than a later contracted ad when the later contracted ad is more behind. As resolved previously by the Board (12/19/2007), this feature is obvious given the disclosure of Carruthers et al. Applicants now argue that Carruthers et al need not select an ad based upon time of contract because of Carruthers et al "pre-acceptance filtering". However, as even applicant is aware, the contract-selection guidance offered by the inventory manager is based on an *estimation* of future ad opportunities. Therefore one of ordinary skill would recognize that turning away business (refusing to accept contracts) base on an estimation would be unwise. What if the estimate was wrong? Underestimating that there will be 1000 ad opportunities when in fact 1050 ad opportunities become reality deprives the system of the revenue for the unexpected 50 extra ad opportunities. Likewise overestimating that there will be 1000 ad opportunities when in fact 950 ad opportunities become reality would lead to an overbooking situation where the system promises advertising opportunities that can't be fulfilled and therefore not everyone gets satisfied. In both of these cases, the well known notion of a first come first served principle would be obvious to employ when selecting ads for insertion. That is, use time-of-contract-acceptance as a parameter in ad selection. Latecomers would be accepted, but not guaranteed any/all of their opportunities. In the first example where underestimation occurred, the latecomer would be happy to learn that extra opportunities became available. In the second example of overestimation, it would be clear why the latecomer

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was not 100% fulfilled – i.e. because the opportunities were not as plentiful and they had to go to earlycomers. It strikes the examiner as similar to flying on an airline as a stand-by passenger. All seats have been sold, but there may be a chance that extra seat opportunities become available (i.e. not all ticketed passengers show up). Maybe they will have room for you (even though the estimation is that they will not), but they tell you to wait until the plane actually fills up or not. If there is still room after the earlier-arrived-customers are seated, the airline can consider people according to their stand-by status. If there are not enough extra seats that become available the latecomer knows why – they were too late. It would have been obvious to have used 1<sup>st</sup>-come, 1<sup>st</sup> served as part of the Carruthers at al's ad prioritization process (i.e. after, and separate from, the steps of actually forming the contracts).

Applicant argues that first-come first-served is an entirely different approach. However one of ordinary skill would see how such an approach can be used to augment the explicit pre-acceptance filtering of Carruthers at al – at least for the reasons of accommodating more people than you first estimated; this enables the business to sell more inventory.

Applicant argues that Carruthers at al teaches creating the ad order at the time of user login and therefore does not have the ability for ad order to change according to a the content of a presently viewed page. Examiner first points out that Carruthers at al incorporates by reference the teaching that ad targeting can be based upon user page history as well as the *currently viewed page content*. Given such a teaching, it would have been obvious to one of ordinary skill at the time of the invention to have inspected

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the user profile or inspected the current page at any time or re-ordered the ad queue at any time, including for each advertising opportunity so that an ad can be operably targeted to the current page content as desired by the incorporated material. One of ordinary skill would have recognized the predictable advantage of targeting to current page content as the user is presumably already in the state of mind consistent with that current page content. For example, while the user is reading an article about the local sports team makes a great time to target advertising for that team's ticket plan. It would have been obvious to one of ordinary skill at the time of the invention to have provided the greater ability to finely target ad content to current page content. Further by checking the user's profile, the advertising can be targeted to the most up-to-date profile and can take into consideration the user's current online session. Further still, Carruthers et al teaches that some advertising can be inserted according to a keyword being entered or to the present URL [0076].

Applicant argues that Carruthers et al lacks slots and lacks slots which have ad-filling attributes corresponding to the content subject. This is addressed in detail above as written in the previous action. Applicant again argues this point by saying that the ad-filled screen real estate of Carruthers et al is not a slot because this real estate is related to a user's viewing space, not the content. Examiner disagrees. The advertising banners chosen by Carruthers which are presented on and according to the content of the presently requested page are inherently taken to reside in slots.

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**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Conferees:

Michael Bekerman /M. B./  
Primary Examiner, Art Unit 3622

Eric Stamber/E. W. S./  
Supervisory Patent Examiner, Art Unit 3622